

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      OCT. 7,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Fabwell, Inc.

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Serial No. 75/088,578

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Terence J. Linn of Van Dyke, Gardener, Linn & Burkhart, LLP  
for Fabwell, Inc.

Allison S.Berman, Trademark Examining Attorney, Law Office  
104 (Sydney Moskowitz, Managing Attorney).

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Before Simms, Cissel and Quinn, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 15, 1996, applicant applied to register the  
mark shown below

on the Principal Register for "vinyl siding," in Class 19. The application was based on applicant's claim of first use of the mark on April 1, 1995, and first use of the mark in interstate commerce on the same day.

The specimens submitted with the application are labels used on containers for applicant's goods. A copy of such label, reduced somewhat in size, is shown below.

The Examining Attorney noted that the drawing submitted with the application shows only the stylized presentation of the letter "F," whereas the specimens display the entire mark "FABWEL." In view of this, she required applicant to submit substitute specimens which show the stylized presentation of the letter "F" used as a mark for the goods set forth in the application.

Applicant responded to the requirement for substitute specimens by describing its mark as a stylized letter "F," and took the position that the specimens of record show trademark use of the letter by itself. Applicant claimed ownership of Registration No. 1,579,760. The mark there is the same mark sought to be registered by means of this application, but the goods are not the same. Instead, they are identified as various metal and fiberglass products, as well as accessories for vehicles. Applicant argued that it used the letter alone and in the advertising of other products, and included with its response examples of such promotional use of the letter by itself. Applicant contended that these materials show that applicant and its predecessor-in-interest have tried to generate a separate and distinct commercial impression for the stylized letter "F."

The Examining Attorney acknowledged applicant's amendment to describe the mark and the claim of ownership of the prior registration, but she was not persuaded by the arguments with respect to the requirement for substitute specimens. The second Office Action made final the requirement for specimens which show use of the mark presented in the drawing as a trademark for applicant's vinyl siding.

Applicant timely filed a Notice of Appeal, along with a request for reconsideration. Included with the request for reconsideration was a declaration from applicant's vice president of marketing to the effect that applicant has used the stylized "F" logo as a service mark and as a trademark for a variety of services and goods, and that in the opinion of the the declarant, the stylized presentation of the letter creates a separate and distinct commercial impression apart from the commercial impression created by the word "FABWEL" as a whole.

A copy of the prior registration of which applicant claimed ownership was included, as well as a copy of another registration, No. 2,055,513, issued to applicant on April 22, 1997, for the same stylized letter "F." In that registration, the services are identified as "plastic molding services."

Also attached were additional printed advertising materials for applicant's vinyl siding. The advertising, however, shows the stylized letter "F" as the initial letter in the word "FABWEL," rather than as a separate trademark for applicant's goods.

The appeal was instituted, but action on it was suspended, and the application was remanded to the Examining Attorney for consideration of applicant's

reconsideration request. The Examining Attorney maintained the requirement for substitute specimens, however, so the application was returned to the Board for resumption of action on the appeal. Both applicant and the Examining Attorney filed briefs.

The sole issue before the Board in this appeal is whether the specimens submitted with this application show the mark sought to the registered used as a trademark for the goods specified in the application. After careful consideration of the record before us in this appeal and the arguments of applicant and the Examining Attorney, we hold that the requirement for substitute specimens is justified.

Trademark Ruled 2.51 (a)(1) provides, in part, that "the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the goods[.]" It is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the specimens, presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See, e.g., *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ 2d 1828 (Fed. Cir. 1988); and *Institut*

National des Appellations D'Origine v. Vintners Int'l Co., Inc., supra at 1197 (Fed. Cir. 1992), citing In re Survel Inc., 181 F.2d 192, 85 USPQ 257 (CCPA 1950); In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983); In re Lear-Seigler, Inc., 190 USPQ 317 (TTAB 1976); In re Tekelec-Airtronic, 188 USPQ 694 (TTAB 1975); and In re Berger Electronics, Inc., 163 USPQ 487 (TTAB 1969). See also, Trademark Manual of Examining Procedure, Sections 807.14 (a) and 807.14 (b), and cases cited therein.

In the case now before the Board, the stylized letter argued by applicant to be its trademark for vinyl siding is so merged with the rest of the word "FABWEL" on the specimens of record that the letter design cannot be regarded as a separable element which creates a separate and distinct commercial impression. The letter, as used on the specimens, does not function in and of itself as a mark for the identified goods. As such, the drawing represents a mutilation of the mark which the specimens show is used on applicant's goods.

Applicant's arguments to the contrary are not persuasive. To begin with, applicant argues that the Examining Attorney "does not analyze whether the subject matter sought to be registered, standing alone, functions

as a designator of commercial origin..." Further, applicant contends that "[t]he proper analysis, in the instant case, is to assess whether the stylized F is independently capable of denoting commercial origin." (brief, p.5).

These arguments represent an obvious misunderstanding of the test to be applied in determining whether the drawing is a substantially exact representation of the mark which the specimens show to be in use. The question is not whether the mark shown in the drawing, if it were "standing alone," is "independently capable" of denoting commercial origin. Indeed, if the mark shown in the drawing were shown standing alone on the specimens submitted with the application, it is unlikely that the Examining Attorney would have required the submission of substitute specimens. Moreover, independent capability to designate commercial origin is not the issue. The issue is whether the specimens show the mark in the drawing used in a way that it actually functions to identify applicant's products. Contrary to applicant's arguments, as we noted above, the specimens in this case do not present the stylized "F" sought to be registered in such a way that it creates a separate, distinct commercial impression apart from that created by the complete word "FABWEL."

The issue is not whether the remaining term "ABWEL" would be registrable if the "F" were removed from the word "FABWEL," but rather simply whether the stylized letter itself creates a separate and distinct commercial impression.

Registration is not mandated by the fact that applicant uses the mark shown in the drawing by itself in advertising materials, or by the fact that applicant has registered that mark for other goods. We must presume that in order to obtain those registrations, applicant demonstrated use of the mark in connection with those products. If the instant application included specimens showing use of the term sought to be registered as a mark for the goods set forth in this application, substitute specimens would not be required.

Lastly, the declaration submitted in support of registration does not persuade us to reach a different result. The contention of applicant's vice president that the stylized letter sought to the registered functions independently as a designation of origin for applicant's vinyl siding is simply not supported by the specimens of record. Applicant's use and registration in connection with other products and services does not overcome the statutory requirement for this application to be supported

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by specimens which show the mark sought to be registered used in connection with the goods specified in this application.

Decision: The requirement for specimens showing the mark sought to be registered used in connection with vinyl siding is affirmed.

R. L. Simms

R. F. Cissel

T. J. Quinn  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

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